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10/699,520	10/31/2003	Jonathan D. Herbach	07844-622001	4224
21876 7590 06/01/2007 FISH & RICHARDSON P.C. P.O. Box 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER COLIN, CARL G	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/699,520

Applicant(s)

HERBACH ET AL.

Examiner

Carl Colin

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Pursuant to USC 131, claims 1-46 are presented for examination.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 10/31/2003 is being considered by the examiner and initialed.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3.1 Claims 1-46 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-57 of copending Application No. 10/699,124. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations of independent claims 1, 23, 39, and 45 of the present application are found in claims 52 and 54 of the copending application 10/699,124 except for the underlined portion: to force the action to be taken “with respect to the second electronic document”. It would have been obvious to one of ordinary skill in the art at the time the invention was made to force the action to be taken with respect to the third electronic document rather than the second electronic document as it is disclosed in claim 32 that document permissions information may comprise policy such as document revocation list. One of ordinary skill in the art would have been lead to do so because if the second electronic document were revoked it would have made sense to force action to the third document, which is a different and associated document with the second document.

Independent claims 16 and 31 recite “opening a locally retained distributed document; contacting a document control server identified from the distributed document and forcing use of a second document in place of the distributed document with respect to at least one document action based on information received from the document control server”, and claims 42 and 54 of the copending application disclose accessing a locally electronic document at the client with respect to at least one document action based on information received from the document control

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server. Claim 19 of the copending application further discloses that the address of the control server may be incorporated into the document. The element that is not disclosed is “forcing use of a second document in place of the distributed document”. As mentioned above, with respect to the rejection of independent claim 1 of the present application, it would have been obvious to one of ordinary skill in the art at the time the invention was made to force the action to be taken with respect to the third electronic document rather than the second electronic document as it is disclosed in claim 32 that document permissions information may comprise policy such as document revocation list. One of ordinary skill in the art would have been lead to do so because if the second electronic document were revoked it would have made sense to force action to the third document, which is a different and associated document with the second document.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-43, and 45-46 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Publication US2002/0087876 to **Larose**.

As per claim 1, Larose discloses a method comprising: receiving a request to take an action with respect to a distributed electronic document (an earlier version, first or second version for instance) (see page 6, paragraph 92 and fig.3); identifying, in response to the request, information associated with the distributed electronic document, the associated information (user identification and version of the document) indicating a second electronic document (second or third version) different from the distributed electronic document (see page 4, paragraph 54 and page 5, paragraph 67); and imparting information concerning the second electronic document to force the action to be taken with respect to the second electronic document (second or third version) (see page 5, paragraph 67).

As per claim 2, Larose discloses the limitation of wherein receiving the request comprises receiving, at a server, the request from a client to take the action with respect to the distributed electronic document (see page 6, paragraph 92 and fig.3), wherein the distributed electronic document (an earlier version, first or second version for instance) is retained locally at the client (see page 6, paragraph 92 and fig.3), identifying the associated information comprises identifying associated information retained at the server (see page 4, paragraph 54 and page 6, paragraph 84), and imparting the second document information comprises relating the second document information from the server to the client (see page 5, paragraph 67).

As per claim 3, Larose discloses the limitation of wherein relating the second document information comprises sending the second document information to the client to allow the client to obtain the second document (see page 5, paragraph 67).

As per claim 5, Larose discloses the limitation of wherein the distributed and second documents comprise different sequential versions of a document (see page 4, paragraph 55).

As per claim 6, Larose discloses the limitation of wherein relating the second document information comprises: obtaining the second electronic document (see page 5, paragraph 66); and sending the second electronic document to the client (see page 5, paragraph 66).

As per claim 7, Larose discloses the limitation of wherein the second electronic document comprises a later version of the distributed electronic document, and the associated information comprises document-permissions information specifying that the action is not permitted with respect to the distributed electronic document at the client (see fig.4).

As per claim 8, Larose discloses the limitation of wherein the document-permissions information specifies access permissions at a level of granularity smaller than the distributed electronic document (see page 5, paragraph 73 and fig.4).

As per claim 9, Larose discloses the limitation of wherein the associated information comprises user-dependent association information indicating the second electronic document,

and obtaining the second electronic document comprises identifying the second electronic document based on the user-dependent association information and an identified user at the client (see page 5, paragraphs 62 and 66-67).

As per claim 10, Larose discloses the limitation of wherein obtaining the second electronic document further comprises generating at least a portion of the second electronic document based on the identified user (see page 5, paragraphs 62 and 66-67).

As per claim 11, Larose discloses, different versions that require conversion that meets the recitation of different formats and further discloses encrypted and decrypted version (see page 5, paragraphs 70 and page 6, paragraph 84) that meets the recitation of wherein the distributed and second documents comprise different format versions of a document.

As per claim 12, Larose discloses the limitation of wherein the distributed electronic document comprises a software program, the second electronic document comprises a later version of the software program, and the action comprises running the software program (page 8, claim 2).

As per claim 13, Larose discloses the limitation of accessing the distributed electronic document at the client (see page 6, paragraph 85);
identifying an address of the server and a document identifier (metadata and security attributes) in the distributed electronic document (see page 6, paragraphs 91-92);

sending the document identifier and the requested action to the server using the address (see page 6, paragraphs 91-92 and page 8, claim 2); and replacing the distributed document, at the client, with the second document (see page 8, claim 2).

As per claim 14, Larose discloses the limitation of wherein replacing the distributed document comprises performing the action with respect to the second document (see page 8, claim 2).

As per claim 15, Larose discloses the limitation of wherein the second document includes the address of the server and a second document identifier, (see page 6, paragraph 92, page 7, paragraph 104, and page 8, claim 2) and replacing the distributed document further comprises writing over the distributed document with the second document in a storage device (see page 6, paragraph 89).

As per claim 16, Larose discloses opening a locally retained distributed document (an earlier version, first or second version for instance) (see page 6, paragraph 85); contacting a document control server identified from the distributed document (see page 6, paragraph 92); and forcing use of a second document (second or third version) in place of the distributed document, with respect to at least one document action, based on information received from the document control server (see page 5, par. 67 and paragraphs 92-95 and claim 2).

As per claim 17, Larose discloses the limitation of obtaining the second document based on the received information (token or mechanism...) (see page 5, par. 67 and page 6, par. 92).

As per claim 18, Larose discloses the limitation of wherein the received information comprises the second document (see page 8, claim 2).

As per claim 19, Larose discloses the limitation of wherein the second document comprises a later version of the distributed document, and forcing use comprises transparently closing the distributed document and opening the second document (see page 7, paragraph 101).

As per claim 20, Larose discloses the limitation of wherein forcing use further comprises transparently overwriting the distributed document with the second document (see page 6, paragraph 89).

As per claim 21, Larose discloses the limitation of wherein the received information comprises document permissions information specifying permissions relating the second document with the distributed document (see page 6, paragraph 84 and page 7, paragraph 95).

As per claim 22, Larose discloses the limitation of wherein the distributed electronic document comprises a software program, the second electronic document comprises a later version of the software program, and the at least one document action comprises running the software program (page 8, claim 2).

As per claim 23, Larose discloses a software product tangibly embodied in a machine-readable medium, the software product comprising instructions operable to cause one or more data processing apparatus to perform operations comprising:

receiving a request to take an action with respect to a distributed electronic document (an earlier version, first or second version for instance) (see page 6, paragraph 92 and fig.3);

identifying, in response to the request, information associated with the distributed electronic document, the associated information (user identification and version of the document)

indicating a second electronic document (second or third version) different from the distributed electronic document (see page 4, paragraph 54 and page 5, paragraph 67); and

impacting information concerning the second electronic document to force the action to be taken with respect to the second electronic document (second or third version) (see page 5, paragraph 67).

As per claim 24, Larose discloses the limitation of wherein receiving the request comprises receiving, at a server, the request from a client to take the action with respect to the distributed electronic document (see page 6, paragraph 92 and fig.3), wherein the distributed electronic document (an earlier version, first or second version for instance) is retained locally at the client (see page 6, paragraph 92 and fig.3), identifying the associated information comprises identifying associated information retained at the server (see page 4, paragraph 54 and page 6, paragraph 84), and impacting the second document information comprises relating the second document information from the server to the client (see page 5, paragraph 67).

As per claim 25, Larose discloses the limitation of wherein relating the second document information comprises sending the second document information to the client to allow the client to obtain the second document (see page 5, paragraph 67).

As per claim 26, Larose discloses the limitation of wherein relating the second document information comprises: obtaining the second electronic document (see page 5, paragraph 66); and sending the second electronic document to the client (see page 5, paragraph 66).

As per claim 27, Larose discloses the limitation of wherein the second electronic document comprises a later version of the distributed electronic document, and the associated information comprises document-permissions information specifying that the action is not permitted with respect to the distributed electronic document at the client (see fig.4).

As per claim 28, Larose discloses the limitation of wherein the associated information comprises user-dependent association information indicating the second electronic document, and obtaining the second electronic document comprises identifying the second electronic document based on the user-dependent association information and an identified user at the client (see page 5, paragraphs 62 and 66-67).

As per claim 29, Larose discloses the limitation of wherein obtaining the second electronic document further comprises generating at least a portion of the second electronic document based on the identified user (see page 5, paragraphs 62 and 66-67).

As per claim 30, Larose discloses the limitation of wherein the distributed electronic document comprises a software program, the second electronic document comprises a later version of the software program, and the action comprises running the software program (page 8, claim 2).

As per claim 31, Larose discloses a software product tangibly embodied in a machine-readable medium, the software product comprising instructions operable to cause one or more data processing apparatus to perform operations comprising:

opening a locally retained distributed document (an earlier version, first or second version for instance) (see page 6, paragraph 85);
contacting a document control server identified from the distributed document (see page 6, paragraph 92); and forcing use of a second document (second or third version) in place of the distributed document, with respect to at least one document action, based on information received from the document control server (see page 5, par. 67 and paragraphs 92-95 and claim 2).

As per claim 32, Larose discloses the limitation of obtaining the second document based on the received information (token or mechanism...) (see page 5, par. 67 and page 6, par. 92).

As per claim 33, Larose discloses the limitation of wherein the received information comprises the second document (see page 8, claim 2).

As per claim 34, Larose discloses the limitation of wherein the second document comprises a later version of the distributed document, and forcing use comprises transparently closing the distributed document and opening the second document (see page 7, paragraph 101).

As per claim 35, Larose discloses the limitation of wherein forcing use further comprises transparently overwriting the distributed document with the second document (see page 6, paragraph 89).

As per claim 36, Larose discloses the limitation of wherein the received information comprises document-permissions information specifying permissions relating the second document with the distributed document (see page 6, paragraph 84 and page 7, paragraph 95).

As per claim 37, Larose discloses the limitation of wherein the document-permissions information specifies access permissions at a level of granularity smaller than the distributed electronic document (see page 5, paragraph 73 and fig.4).

As per claim 38, Larose discloses the limitation of wherein the distributed electronic document comprises a software program, the second electronic document comprises a later

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version of the software program, and the at least one document action comprises running the software program (page 8, claim 2).

As per claim 39, Larose discloses a system comprising:

a client operable to send a request to a server when an action is to be taken with respect to a distributed electronic document local to the client (an earlier version, first or second version for instance) (see page 6, paragraph 92 and fig.3); and a server operable to receive the request, and in response to the client, the server being operable to identify information associated with the distributed electronic document, the associated information (user identification or version of the document) being retained at the server and indicating a second electronic document (second or third version) different from and associated with the distributed electronic document (see page 4, paragraph 54 and page 5, paragraph 67), the server being operable to relate information concerning the second electronic document to the client to facilitate the action to be taken (see page 5, paragraph 67).

As per claim 40, Larose discloses the limitation of wherein the server comprises:

a server core with configuration and logging components (see page 6, paragraphs 84 and 92 and page 8, claim 27);
an internal services component that provides functionality across dynamically loaded methods; and dynamically loaded external service providers, including one or more access control service providers (see page 6, paragraphs 84 and 92).

As per claim 41, Larose discloses as interpreted by the Examiner **Larose** discloses different websites associated with different servers that meets the recitation of a business logic tier comprising a cluster of document control servers, including the server (see page 5, paragraph 65 and page 7, paragraph 104); an application tier including the client comprising a viewer client (user interface) (see page 6, paragraphs 85 and 92), a securing client (see paragraph 91), and an administration client (such as binding and inspection functions) (see paragraphs 82-83); and a load balancer that routes client requests to the document control servers (see page 6, paragraph 92 and page 7 paragraph 104).

As per claim 42, Larose discloses the limitation of wherein the server comprises a permissions-broker server including a translation component (see page 4, paragraph 59), the local electronic document comprises a document secured previously by the permissions-broker server, and the translation component being operable to translate first document-permissions information in a first permissions-definition format into second document-permissions information in a second permissions-definition format in response to the request being received from the client (see pages 4-5, paragraphs 59-62 and 67).

As per claim 43, Larose discloses the limitation of wherein the server (first computer) comprises a permissions-broker server operable to obtain and send, in response to the request, a software program comprising instructions operable to cause one or more data processing apparatus to perform operations effecting an authentication procedure, and the client uses the authentication program to identify a current user and control the action with respect to the second

document based on the current user and document-permissions information associated with the second document (see page 3, paragraphs 35-36).

As per claim 45, Larose discloses a system comprising:

client means for contacting a server when an action is to be taken with respect to a distributed electronic document local to the client (an earlier version, first or second version for instance) (see page 6, paragraph 92 and fig.3); server means for identifying and relating information (user identification or version of the document) concerning a second electronic document (second or third version) different from and associated with the distributed electronic document that is to be operated on in place of the distributed electronic document with respect to the action (see page 4, paragraph 54 and page 5, paragraph 67).

As per claim 46, Larose discloses the limitation of server means for mapping first document-permissions information in a first permissions-definition format to second document-permissions information in a second permissions-definition format, the first document-permissions information being associated with an electronic document (see pages 4-5, paragraphs 59-62 and 67); and client means for controlling actions with respect to the electronic document based on the second document-permissions information (see page 3, paragraphs 31, 35-36); wherein the first permissions-definition format includes at least one type of permission information that cannot be fully defined in the second permissions-definition format used by the client means (see page 3, paragraph 36 and figs.4-5).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication US2002/0087876 to **Larose**.

As per claim 4, Larose substantially discloses the claimed method of claim 2. **Larose** also suggests that the invention is not limited to a specific type of version. “Persons having ordinary skill in this art will readily recognize that the present invention can be incorporated into any number of types and versions of software application” (see page 4, paragraph 57). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of **Larose** to include different type of versions including language versions of a document as suggested by **Larose**. One of ordinary skill in the art would have been motivated to do so because it would allow the invention to be implemented with different platforms and instead of being limited to a single platform (see also paragraph 96).

5.1 **Claim 44** is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication US2002/0087876 to **Larose** in view of Non-Patent Literature “PageRecall: The Key to Document Protection, Authentica, Inc. Whitepaper, <http://www.authentica.com/products/white.>” (Applicant’s IDS).

As per **claim 44**, **Larose** substantially discloses the system of claim 39, wherein the server comprises a document control server operable to synchronize offline access information with the client in response to the client request (see page 6, paragraph 92), the offline access information comprising a first key associated with a group, the first key being useable at the client to access a third document by decrypting a second key (token) in the third document, and the client allows access to the third document, when offline, by a user as a member of the group, using the first key to decrypt the second key in the third document and governing actions with respect to the third document based on document-permissions information associated with the third document (see page 6, paragraphs 91-92). Although **Larose** is silent about whether the decryption is performed “offline”, in one embodiment it is disclosed that the software may be already installed and the client once authenticated can access the document (see paragraph 93). However, Non-Patent literature by Authentica in an analogous art discloses document protection wherein in “work offline mode” users can access encrypted document offline once the user authenticates to the server, the server will send a copy of the key for decryption of the authorized document (see page 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of **Larose** to allow the document to be accessed offline once the user is authorized as suggested by Non-Patent literature by Authentica.

One of ordinary skill in the art would have been motivated to do so because it would allow access of the document at any place and transparently to users while still providing security by encryption as suggested by the Non-Patent literature by Authentica (see page 6).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as the art discloses file encryption protection and security information associated with a second document to force action with respect to the second document. (See PTO-form 892).

6.1 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser G. Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from

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a USPTO Customer Service Representative or access to the automated information system, call
800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Carl Colin", with a stylized flourish at the end.

Carl Colin

Patent Examiner, AU 2136

May 28, 2007